REMARKS:

The Examiners recitation of the status of the claims in the office action mailed January 18, 2006 is correct. Claims 1-18 are under prosecution in this application. The Examiner has re-affirmed his rejection of the claims under 35 USC § 112 paragraph one. The Examiner has acknowledged receipt of Applicant's submission of an Affidavit under rule 132 establishing the level of competence of Applicants peers (those skilled in the art) at the time of the invention in late 1995. The Examiner then asserts that the affiant, Mr. Hardin, explained his own technique for assigning a range of values for each answer in a questionnaire, referring to line 3 of the Affidavit by Mr. Hardin. The Applicant respectfully submits that the Examiner's analysis of the Affidavit is flawed. Firstly, the Examiner admits that the Affidavit establishes a level of competence of Applicant's peers (those skilled in the art) at the time of the invention in late 1995. The Examiner is correct; Mr. Hardin does describe his own technique. However, at line eleven, Mr. Hardin explains, "These types of investigations and analysis were commonplace in late 1995, generally through pre programmed computers..."

The sworn testimony of Mr. Hardin is that, "One skilled in the art would have known in 1995 how to program or operate a computer, pre-programmed with an EXCEL* spreadsheet, to conduct the very steps that Applicant has conducted on his computer to carry out the invention.

The Examiner continues, "The question here is clearly not how to program a computer, it is how does the actual program or software (Applicant's own invention) that will be executed on a computer (any computer) perform Applicant's invention." Applicant's invention is not "... the actual program or software..." Applicant's invention is set forth in claims 1-18 as a process for evaluating the strength of a specific Intellectual Property for purposes of commercializing it comprising the steps of:... "

The computer and its associated EXCEL spreadsheet is merely the means by which the process for "evaluating"... is performed. The Examiner is clearly asking the question, how does an EXCEL spreadsheet work in conjunction with a computer (read as microprocessor) work. The Applicant respectfully reiterates that the inventive method comprises the steps of interacting with a computer which is generally pre-programmed. Page 5 lines 13-15. Clearly, the Applicant is not required to teach how to program a computer nor teach how an EXCEL spreadsheet (software) works in conjunction with a computer (microprocessor) to carry out the steps taught and claimed for "It is well known that a patent disclosure need not enable information within the knowledge of an ordinary skilled artisan. Thus, a patent preferably omits from the disclosure any routine technology that is well known at the time of the application." See Hybritech, Inc. the Monoclono Antibodies, Inc. 802 Fed. 2nd 1367, 138 (Fed cir 1986).

*EXCEL is a registered trademark of Microsoft Corporation

The Examiner continues to raise the question, "... how does Applicant's system convert text, essay questions and responses into computer data and how does it take into account all of these subjective risk factors which the calculation process appears to entail?" As stated previously, it is clearly explained how to convert text and essay questions and responses into data at page 5 of the specification. The first step is entering data from a questionnaire completed by the owner of the Intellectual Property or on his behalf. The computer is pre-programmed such that the data is organized by pre-determined risk factors, which list of factors is set forth at page 12 et. seq.

The data is then evaluated by comparing it to a pre-set standard for that risk factor in question and computing a score which represents a relative degree of strength associated with the specific Intellectual Property. It is explained at page 7 that a standard is a mean or average of the data in each risk factor data base. The specific risk factor is then expressed in terms of a relative risk factor; in other words, relative to the mean. It is elementary that a risk factor greater than the average bodes against investing in or bringing a lawsuit on a patent. Even the board had no difficulty in recognizing the value of Applicants "score", as they referred to it. Consequently, the Applicant, with all due respect, disagrees with the Examiners assertion that there is no indication in the specification of how the composite score is used to evaluate the strength of a specific Intellectual Property.

Specifically, the specification itself clearly instructs one skilled in the art how to proceed to practice the claimed invention. On page 5 at line 13, the instruction is given "The inventive method comprises the steps of interacting with a computer which is generally pre-programmed... the memory is programmed such that the data is organized by predetermined risk factors." In January of 1996, one skilled in the art would quickly recognize that this step can be accomplished by using a EXCEL spreadsheet, see Affidavit line 13, and listing in columns the risk factors, selection of which is specific to the Intellectual Property in question. With respect to a product protected by a patent, it is taught on page 11, at line 16 "... information concerning the product maybe highly relevant, for example, perhaps the product uses scarce raw materials. 'One would conclude that scarce raw materials would be an impediment to large volume production and larger royalties. 'Similarly, the need for highly skilled labor would reduce the potential for large royalties and again would be a consideration in determining the relative risk. 'Also considerations such as any resulting toxic or pollutant materials as a by-product may be again a deterrent to going into production and therefore lessens the chances of a large monetary gain." Thus, Applicant has clearly instructed that one skilled in the art to consider those applicable risk factors from the list of 100 set forth and compile them using an EXCEL spreadsheet.

Having thus established the risk factors by considering those which are relevant to the product in question as instructed above, data is entered from a questionnaire (see lines 3 through 7 of the Affidavit) concerning the Intellectual Property or from the results of a series of completed tasks which tasks are set forth on pages 27 & 28, and from

other sources which sources are specifically set forth in columnar form in Figure 1. The computer will sort the data entered and place it in the column under the risk factor heading to which it applies. The risk factors are then weighted, and, as taught on page 7, lines 12 through 14, the weight given to each is derived from estimates or actual experience gained through a test marketing program.

In late 1995 one skilled in the art would recognize that to weight a risk factor one must compare it to some standard. The Applicant clearly instructs how to determine that standard on page 8 at lines 11 et. seq. "The process of determining the standard... can be accomplished by applying actual experience factors to calculate the standard. 'Compiling this experience data enables one to establish a norm or an average... 'Then an individual patent risk factor... is compared to this average and the relative [weighted] risk factor is obtained." The Affidavit further elucidates the method for determining standards and weight factors known at the time of the invention.

The Applicant's instructions are clear and unambiguous 1.) Look at the Intellectual Property to be evaluated, and identify the characteristics of the product defined and claimed. Select from the risk factors presented those which appear relevant (page 11, line 16 et. seq.) 2.) Estimate a relative value for each risk factor, selected, or if available, use values from a questionnaire (page 5 line 15 et. seq.). This second step would have been easily accomplished by one skilled in the art in late 1995, simply by selecting a range of values for an example: from 1 to 5 or from 1 to 10 and assigning a number by estimation to that particular risk factor (see Affidavit lines 4 et. seq.). 3.) Continue adding estimated or experimentally determined values for each of the risk factors until a table is constructed from which a mean is derived, which then allows one to compare the mean to the risk factor in question thereby resulting in a weighted (relative) risk factor.

The idea of assigning values to investigated criteria and creating a table are not new concepts, since persons routinely apply numbers to written concepts to evaluate them. This technique is used in all aspects of both physical as well as social sciences. Individual behaviors, answers to essay questions, effects of treatments are just a few of the literally hundreds of thousands of situations where numbers are used to quantify and evaluate ideas, results, concepts and assessments. This capability in late 1995 was inherent in any person operating a computer with and EXCEL spreadsheet.

With respect to the Examiner's continued rejection of the claims under 35 USC 101 that the claims do not define an invention which produces a concrete result, Applicant again directs the Examiners attention to State Street Bank and Trust Co. vs. Signature Financial Group, Inc. 149 Fed 3rd 1368. At headnote 6, the court was clear on the interrelationship between the terms practical, useful, concrete, and tangible. The court commenting on the Diehr case, 450 US 175, said, "As in Diehr, the court [there] explained that certain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas until reduced to some type of **practical application**, i.e. "a useful, concrete, and tangible result". The court was quite clear that **practical**

encompasses all and includes as component parts, useful, concrete and tangible results. The term **practical** is generic to the terms useful, concrete, and tangible. The Board in this case, having found the generic, left no room of the Examiner to argue that one of the included components was absent.

Moreover, the Examiner's assertions that there is lack of clarity with respect to what is considered low and what is considered high and that there is no indication of how the composite score is used to evaluate the strength of a specific Intellectual Property, nor how the probable success factor is used in undertaking a lawsuit is simply trumped by the Board's holding that "The calculation of a score for determining probability of success in a lawsuit or for determining the relative strength of undertaking commercialization of an Intellectual Property is clearly a tangible, useful, and practical result which is attained by the instant claimed invention."

The functionality of the programmed computer is clearly set forth in the specification. It is clear beyond doubt that disclosure of a software program is not necessary... where the functions of the software program were readily apparent from the specification and one skilled in the art could generate the necessary software program to implement the disclosed functions. See Fonar Corp. the General Electric Co., 107 Fed 3rd 1543, 1549, 41 US PQ 2nd 1801, 1805 (Fed cir 1997).

CONCLUSION:

In view of the above remarks and cited cases, Applicant believes the claims of the above identified application are in condition for allowance and respectfully request such action.

Respectfully submitted,

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